

REMARKS**Paragraph 3 of the Office Action**

Claims 1 and 10 are objected to because of informalities.

5 The informalities have been corrected in a manner believed to overcome the objection.

Withdrawal of the objection is respectfully requested by the applicant.

Paragraphs 4-9 of the Office Action

10 Claim 1 are rejected under 35 USC §102(b) as being anticipated by U.S. Patent Number 6,823,883 to Sears. Claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 1,865,533 to Lutzke

Claim 1 has been amended to include the limitations of as-filed claim 2 and is believed to overcome the above rejections.

15 The applicant respectfully requests withdrawal of the rejection.

Paragraphs 10-15 of the Office Action

Claims 1-6 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 5,727,700 to Digney, and further in view of U.S. Patent Number
20 5,560,502 to Hsiung. Claims 7-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Digney in view of Hsiung as applied to claims 1-6 above, alone.

It is respectfully submitted to the Examiner that what one could do with the elements found in prior art references is not analogous to what one would do with those elements when reading the prior art references without knowledge of the applicant's
25 specification. The Examiner has stated that the two devices are analogous because they overlap in class 211. That does not make them analogous and that does not prove that there is any motivation to make the combination as cited by the Examiner.

First, the advantages and usage of the two devices are contrary to each other. Digney teaches a device that contains items that float, whereas Hsiung teaches a device
30 from which things will hang.

In each case, the downwardly-open interior cavity 26 will be available to hold available balloons 104 while the perimeter downwardly-open channel 12 holds display balloons 100 in a non-rotating position so that the decorative face is visible through the outside retaining member 20.

5

Digney, column 5, lines 25-30 (emphasis added).

A hanging bar 6 may be provided to hang between the two side bars 14 for supporting clothe hangers (not shown).

10 Hsiung, column 5, lines 44-45 (emphasis added). Thus, one device has a downwardly-open interior cavity extending opening for receiving balloons which are floating (and therefore require the downwardly-open interior cavity), while the other device includes a bar from which to hang hangers. One skilled in the art would only see a discontinuity in usage and would therefore find no motivation to make the combination.

15 Second, Digney specifically calls for a structure that allows full viewing of the balloons while they are in an inflated state and therefore requires an above head display that is attached to a ceiling. In fact, that is the sole purpose of the Digney device. Digney states that overhead displays are the preferred manner to display a balloon because they encourage impulse buys but those devices often hide the face of the balloon.

20 The inflated balloon in an overhead net is ready for an impulse buy, but only if the potential purchaser is lucky enough to spy its attractive decoration.

Digney, column 1, lines 47-50. However, the device of Digney is modified to ensure that a potential customer will see the face of the balloon while it is in its prime location -

25 which is an overhead display.

It is therefore an object of the present invention to provide an overhead display unit for a plurality of inflated balloons, each said balloon having a characteristic pillow shape with a generally planar front and back surface decorated with indicia, such display unit having a peripheral structure to position and display a decorative indicia for viewing by prospective purchasers.

30

Another object is to provide such a display unit which requires a minimal amount of support from the ceiling system from which it is suspended.

Digney, column 1, lines 55-64 (emphasis added). Hsiung contradicts the advantages and motivation behind the Digney device. Hsiung would prevent Digney from being an overhead display since the modifications added by Hsiung would form a device that is supported by a floor surface, not by a ceiling. This would hinder the viewing of the

35

balloons and counters the primary advantage of the Digney specification. Therefore, there can be no motivation to make the combination as claimed by the Examiner.

Third, Hsiung also includes a cover for enclosing the closet of Hsiung, which is contradictory to the stated goal of Digney - i.e. the easy viewing and the applicant's
5 claimed limitation of open sides.

It is quite apparent that a soft flexible material sheet may be attached to the closet frame structure 100 to cover the inside space thereof so as to complete the construction of the closet.

10 Hsiung, column 5, lines 51-55. One skilled in the art of balloon supports would never want to enclose the space with a cover as that cover would prevent the viewing and easy access to the balloons. It is a function of the downwardly-open cavity that decidedly rejects any requirements of a cover. There simply can be no motivation to combine Digney and Hsiung to form the applicant's device and any suggestion to the contrary
15 would necessarily be based on impermissible hindsight. For the above reasons, claim 1 and all claims depending therefrom are believed to be in condition for allowance.

With respect to the Examiner's claim that wheels are well known on carts, it is respectfully submitted to the Examiner that even were this statement true, the Examiner still must find motivation to make the assertion. Digney teaches a device that is hung
20 from a ceiling. For what purpose would Digney want or even be able to utilize wheels? It has already been shown above that the combination of a ground supported frame structure is contradictory to the purpose and advantages of the Digney device. Thus, adding wheels to the combination is also contradictory to the teachings of Digney. Further, Hsiung is a closet meant to replace conventional wooden closets but with the
25 advantage of being collapsible. Hsiung, column 1, lines 11-29. Conventional closets do not have wheels and therefore there is no support in the prior art for such a combination and any assertion of the opposite must be accompanied with a reference showing such and providing the proper motivation.

The applicant respectfully requests withdrawal of the rejection.

30

Paragraphs 16-19 of the Office Action

Claims 2, 5, and 7-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Number 6,823,883 to Sears as applied to claim 1 above, and further in view of U.S. Patent Number 6,470,515 to Hsia.

5 It is respectfully submitted to the Examiner that there can be no motivation to combine Sears with Hsia. In the present case, not even Sears reads upon the applicant's device as Sears specifically calls for a canopy that will provide shade from the sun. The applicant specifically calls for a cage to allow viewing of the balloons. A canopy is not analogous to a cage and therefore any combination including Sears cannot read upon the
10 applicant's claims. However, the Examiner has still combined Sears with Hsia in order to supposedly find the elements of the applicant's device. The Examiner states that the motivation would have been to provide additional support to the lower loop via a fourth closing connector. The Examiner has no evidence that the 3-sided base of Sears would be any more stable with a fourth closing connector than it is in its original orientation.
15 The opposite may be equally advantageous, as a fourth closing connector will present an obstacle when getting into and out of the chair positioned under the canopy. Further, there is absolutely no support within the Hsia or Sears that Sears would be benefited by the attachment of wheels. Sears is already a portable device which is lightweight, and therefore easy to move, and would not require wheels since it will be set up where
20 needed. The wheels would also increase the height of the fourth closing connector and make it even more of an obstacle or hazard to be tripped over when a person is attempting to get into the chair.

The assertions being made by the Examiner are a product not of the motivation or teachings within Hsia or Sears, but a product of the applicant's claims which are being
25 used as a template. This is obvious as each of the Examiner's assertions are based only on the Examiner's opinion and not found within any statements of Hsia or Sears. In fact, a person skilled in the art of storing balloons and looking at these two devices would see no similarities at all between the two devices as none exist. This is not the law. The law is clear that obviousness is not established by what could be done, but instead what would
30 be done when one is presented with the prior art, in a vacuum, and without the benefit of the applicant's specification. This is achieved through the requirement of motivation,

which must be supplied by the prior art itself and cannot be gleaned from the applicant's specification.

5 [E]very element of a claimed invention may often be found in the prior art. See
id. However, identification in the prior art of each individual part claimed is
insufficient to defeat patentability of the whole claimed invention. See id.
Rather, to establish obviousness based on a combination of the elements disclosed
in the prior art, there must be some motivation, suggestion or teaching of the
desirability of making the specific combination that was made by the applicant.
See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir.
10 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). It is evident that nearly any
application for a patent would be denied patentability were an Examiner allowed to
simply pick and choose elements from prior art references, absent motivation, as nearly
15 all inventions are combinations of known elements. Such is the present case and
therefore it is believed that all remaining claims are in condition for allowance.

The applicant respectfully requests withdrawal of the rejection.

20

CONCLUSION

5

In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

10



Date: 4/29/06

Sean A. Kaufhold (Reg. No. 46,820)
P.O. Box 89626
Sioux Falls, SD 57109
(605) 334-1571 FAX (605) 334-1574

15